



172

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLN. OF: XU et al.
SERIAL NO: 10/751,230
FILED: January 2, 2004
FOR: METHOD AND SYSTEM FOR MORE EFFECTIVE PROTEIN...
DOCKET: GLH 08-896943 CONFIRMATION NO. 1114

MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR CLARIFICATION OF ACTION

Dear Sir:

The Office Action dated October 16, 2009 is at hand.

The Action notes the Office Action Summary, Form PTOL-326 and Form PTO-892 as attached. While a Form PTO-892 was attached, it was blank. If the Examiner meant to cite additional prior art, it is not listed on Form PTO-892.

The Examiner is respectfully requested to issue a corrected Action and to reset the term for response to run from the issuance of the corrected Action.

Respectfully submitted,

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Serial No. 10/751,230
Docket No. GLH 08-896943
Request For Clarification of Action

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being sent via facsimile addressed to: Office of Initial Patent Examination's Filing Receipt Corrections, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, at number 571-273-8300 on October 20, 2009 at Tucson, Arizona.

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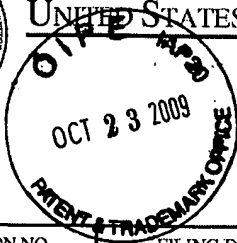
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/751,230

01/02/2004

Jinbo Xu

GLH 08-896943

1114

27667 7590 10/16/2009
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OCT 16 2009

HAYES SOLOWAY P.C.

EXAMINER

BORIN, MICHAEL L

ART UNIT	PAPER NUMBER
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1631

NOTIFICATION DATE	DELIVERY MODE
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10/16/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

admin@hayes-soloway.com
smckniff@hayes-soloway.com
nsoloway@hayes-soloway.com

11-16-09 2-16-10
12-16-09 3-16-10
1-16-10 4-16-10

dkf/sm

Office Action Summary	Application No.	Applicant(s)	
	10/751,230	XU ET AL.	
	Examiner	Art Unit	
	Michael Borin	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1631

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/23/2009 has been entered.

Per Applicant's petition filed 01/23/2009 to suspend further prosecution, the prosecution was suspended for three months.

Status of Claims

1. Claim 1 is amended. Claims 1-11,13,15 are pending.

Rejections not reiterated from previous Office actions are hereby withdrawn. The following rejections constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 1631

3. Claims 1-11,13,15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The instant claims are drawn to a computer process of aligning query protein sequence with protein structures. The method includes computational steps of selecting functions and constraints, and performing linear programming analysis.

To qualify as a statutory process, the claims should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state or thing. See *In re Bilski* (In re Bilski, 88 USPQ2d 1385 Fed. Cir. 2008). The use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. Further, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. In the instant case, claims do not recite any physical transformation step. Further, there is no step in the claims that recites a tie to another category of invention. Therefore, the claims are drawn to non-statutory subject matter for failing to recite a step that ties the method to another category of invention.

Further, as argued previously, the claims do not have practical applicability as they end in the result which is not tangible.. The last recited step of the method of the amended claim 1 is outputting the structure that optimally aligns as the best fit (for

Art Unit: 1631

claim 15 the output is an energy score). However, as the claim does not specify the nature of the "output" it encompasses outputting result in a form not immediately available to a user, e.g., to internal memory of a computer. This may take entirely within the confines of a computer or human mind without any communication to the outside world. In addition, being output might mean being output to Internet via carrier waves (see p. 22, lines 19,20) ", which cause said claims to being drawn to non-statutory subject matter. A claim must be limited only to statutory embodiments - thus, if the claim is broader than the statutory embodiments of the claim, the Examiner must reject the claim as non-statutory.

Furthermore, in regard to claim 15, "Computer-Related Inventions" section of the MPEP at section 2106, Part IV, subpart B, also clarifies that claiming non-statutory subject matter on a computer system or medium or in software does not prevent this rejection.

Claim Rejections - 35 USC § 102 and 103.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,2,15 are rejected under 35 U.S.C. 102(b) as anticipated by Meller et al (Meller et al. Proteins: Structure, Function, and Genetics, 2001, Volume 45, Issue 3 , Pages 241 – 261).

The instant claims are drawn to method of aligning a query protein sequence with a template comprising a set of pre-selected protein structures in a database, comprising the steps of:

- selecting an energy function, said energy function being a linear combination of energy parameters, with weight factors as coefficients;
- establishing linear programming (LP) constraints for threading (or aligning) said query protein sequence with each structure in said set of pre-selected protein structures in a database;
- and performing a linear programming analysis based on a linear programming formulation including said energy function under said constraints,
- to optimally align said query protein with said template,
- the structure of the template that optimally aligns with the query protein sequence identified as the best fit.

Meller et al teach scoring method for sequence-to-structure alignments with parameters optimized by linear programming (LP). The method comprises steps of

- selecting an energy functions including energy parameters and weighting factors, determining values for weighting factors in said energy function (see pp. 242-244),

Art Unit: 1631

- using linear programming (LP) to identify constraints for threading. p. 243, right column through p. 244, left column, Table II, or p. 245, right column, or p. 248, left column last line.
- Performing linear programming on training sets of proteins (viewed as templates) - see, for example, p. 244, left column, pages 245-246.
- Performing threading to optimally align query protein. p. 251-255

Applicant repeatedly acknowledged that Meller et al describe use of linear programming and threading but argues that the referenced method does not perform threading using linear programming. However, as argued previously, the instant claims while stating establishing LP constraints for threading (which Meller reference does as well), do not explicitly state using LP for threading itself. The language "performing linear programming analysis" does not mean that threading itself is done using LP.

Further, the claims use open-ended language "comprising", and as such, may encompass any other steps, such as using dynamic programming addressed in the reference.

5. Claims 3-7,11,13 are rejected under 35 U.S.C. 103(a) as obvious over Meller et al in view of Akutsu et al. in view of Akutsu et al. (On the Approximation of Protein Threading. RECOMB, 1997, p. 3-8)

The reference of Meller et al is applied as above.

With respect to claims 3-7,11,13 if there are any differences between Applicant's claimed method and that of the prior art, the differences would be appear minor in nature. Although the prior art do not teach the various limitations of linear programming

analysis and graph analysis, it would be conventional and within the skill of the art to select and/or determine such conditions as their selection for the intended purpose of obtaining successful protein threading algorithm is well known in the art; and the selection of appropriate parameters for linear programming is conventional and within the skill in the art to which this invention pertains. See Akutsu et al, for example.

Conclusion.

6. No claims are allowed

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (571) 272-0713. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran can be reached on (571)272-0720 . The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1631

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Borin, Ph.D./

Primary Examiner, Art Unit 1631

Notice of References Cited

Application/Control No.

10/751,230

Applicant(s)/Patent Under
Reexamination
XU ET AL.

Examiner

Michael Borin

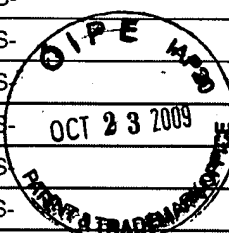
Art Unit

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Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-			
	B	US-			
	C	US-			
	D	US-			
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NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
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*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.